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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,103	07/12/2001	Everett E. Schulze JR.	A63-004-03-US	2069
54092	7590	11/17/2005		
NORTH OAKS PATENT AGENCY 45 ISLAND ROAD NORTH OAKS, MN 55127			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,103	Applicant(s) SCHULZE ET AL.	
	Examiner Donald L. Champagne	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 June 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Rando et al. (US005128520A) in view of Fajkowski (US005905246A).
3. Rando et al. teaches (independent claims 1 and 10) a method and system for redeeming coupons, the method comprising the steps of: determining, at the store with the coupon redemption system **10**, that coupons from different manufacturers are to be redeemed (col. 2 lines 30-34 and col. 2 lines 7-16 and 55), which reads on determining that a first coupon from a first product manufacturer and a second coupon from a second product manufacturer are to be redeemed; rejecting, at the store with the coupon redemption system **10**, a coupon (col. 5 line 47, *found to be invalid*), which reads on a third coupon; and *crediting the retailer automatically* (col. 1 line 64), which reads on reimbursing the store for the first and second coupons through the use of the coupon redemption system (even if the payment is done offsite, the source information must come from the onsite system **10**). Rando et al. also teaches (claim 10) that the "first" coupon is to be redeemed and modified (col. 3 lines 49-54) and that the "second" coupon is to be redeemed and audited (col. 10 lines 61-66). Rando et al. also teaches inherently (claim 10) that the third party service provider is "different" from the first and second manufacturers. As evidence tending to show inherency, it is noted that the third party service provider would inherently use at least some different employees to conduct its business.
4. Rando et al. does not teach accepting the third coupon at the store after the third coupon is rejected by the coupon redemption system. Fajkowski teaches accepting the third coupon at the store after the third coupon is rejected by the coupon redemption system (col. 19 lines 51-56). Because Fajkowski teaches that this enhances customer service (col. 2 lines 15-

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- 16), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Fajkowski to those of Rando et al.
5. Fajkowski also teaches (claim 1) a *third party clearinghouse* (col. 2 lines 37-38) that is "associated with" the coupon redemption system (col. 5 lines 14-22). Such clearinghouses are well known, and one of ordinary skill in the art would readily recognize that said third party clearinghouse is "different from manufacturers of products associated with the first, second and third coupons" (claim 10).
 6. Rando et al also teaches claim 9 at the citations given above.
 7. Rando et al also teaches claims 5 and 12 (col. 7 lines 7-15 and Fig. **2B**). Fajkowski also teaches claim 11 (col. 22 lines 39-41).
 8. Concerning claim 2, Fajkowski teaches *reporting* (recording) transaction information (col. 22 lines 31-35), but does not teach checking whether reimbursement is to be made to the store. Because the store has little to lose and much to gain by making such checks, they would be obvious. Fajkowski also teaches (claims 4 and 13) coupon scanning at a clearinghouse (col. 2 lines 35-42), which reads on obtaining information with a coupon redemption subsystem (claim 4) or an auxiliary coupon reader device (claim 13) at a location different from the store. However, Fajkowski does not teach determining whether to reimburse the store for the third coupon based on the information so gained. This would be obvious because the clearinghouse and manufacturers want to maintain good relations with their customers the stores.
 9. Claim 3 is taught inherently from the teaching in Fajkowski concerning claim 4 (col. 2 lines 35-42). Because unprocessed coupons are valuable, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said container secure, which reads on claim 7. (It is not claimed or disclosed that the three lock box units are separate.)
 10. Claim 6 is obvious in view of the Fajkowski teaching that the *clearinghouse 300* can compile and report the amount to be reimbursed for the first coupon *with a minimum of delay and allow prompt repayment by the manufacturers* (col. 23 lines 29-36). It would have been obvious to one of ordinary skill in the art, at the time of the invention, that a *minimum of delay and prompt repayment* would mean about one day. It would also have

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been obvious that reimbursement for the second coupon would require more than day if it had to be audited.

11. Claim 8 is obvious because the manufacturer is the source of funds and they would want to maintain positive float.
12. Neither reference teaches (claim 14) means for check writing and wire transfer. Both are common, and therefore obvious, means for transferring funds.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
16. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

18. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
19. Applicant may have after final arguments considered and amendments entered by filing an RCE.
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

12 November 2005